

Applicants provisionally elect, without prejudice, the invention of Group III, Claims 21 and 38-45, drawn to a product, for examination and prosecution on the merits. Notwithstanding this, applicants respectfully traverse the restriction requirement for the reasons stated below.

The two criteria for a proper requirement for restriction among patentably distinct inventions are:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required.

M.P.E.P. §803. Both of these criteria must be satisfied for a proper restriction requirement. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." *Id.*

Inventions are considered to be distinct if either or both of the following can be shown:

(1) that the process as claimed can be used to make other and materially different product, or (2) that the product as claimed can be made by another and materially different process. M.P.E.P. § 806.05(f). The examiner has concluded that the inventions of Groups II and II are not distinct because "the product as claimed can be made by another and materially different process other than coating such as by forming self-supporting sheets and laminating them to form the product."

Applicants respectfully disagree. Claims 21 and 38-45 (Group III) are drawn to a product formed by a process defined by one or more of the claims of Group II. Independent claim 21 (Group III) includes all of the limitations of claim 11 (Group II); independent claims 38 and 40 (Group III) include all of the limitations of claim 28 (Group II); and independent claim 39 (Group III) includes all of the limitations of claim 37 (Group II). The product *as claimed* cannot

be made by another and materially different process because the claims require that the product be formed by a particular process, *i.e.*, a process defined by one or more of claims 11, 28, and 37. Applicants respectfully submit that the product defined by claims 21 and 38-45 is not distinct from the method of Group II at least as defined by claims 11, 28, and 37.

Additionally, the examiner has provided no evidence that a serious burden would occur if restriction were not required. With respect to the invention of Groups II and II, applicants submit that a thorough search of prior art relevant to the claimed product will necessarily require a search of methods for making such a product.

Applicants also note that the limitations of the claims of Group I overlap considerably with the claims of Groups II and III. For example, claims 11 (Group II) and 21 (Group III) include all of the limitations of independent claim 7 (Group I); claim 12 (Group II) includes all of the limitations of independent claim 1 (Group I); claim 13 (Group II) includes all of the limitations of independent claim 5 (Group I); claims 28 (Group II), 38 (Group III), and 40 (Group III) include all of the limitations of independent claim 24 (Group I); claim 29 (Group II) includes all of the limitations of independent claim 22 (Group I); and claim 30 (Group II) includes all of the limitations of independent claim 23 (Group I). Applicants respectfully submit that a thorough search of prior art relevant to the claimed coating method or product produced by coating will require a search of methods of preparing certain aqueous suspensions useful in making coating and coating products. Accordingly, applicant submits that the search and examination of the claims of Groups I can be made at the same time as the search for Groups II and III without serious burden. Indeed, it would appear to be more burdensome to conduct

separate searches of substantially the same subject matter at different times for the invention of Group I and the inventions of Groups II and III if the restriction requirement were maintained.

CONCLUSION

In view of the foregoing, applicant respectfully requests that the examiner reconsider and withdraw the restriction requirement and examine all of the claims on the merits. Alternatively, applicants request that the restriction requirement as applied to Groups II and III be withdrawn and that claims 11-21 and 28-45 be examined on the merits.

Respectfully submitted,

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